

REMARKS/ARGUMENTS

A Request for a Three (3) Month Extension of Time Pursuant to 37 CFR

§1.136(a) and (b) is attached hereto.

The above-captioned patent application has been carefully reviewed in light of the non-final Office Action to which this paper is responsive.

Claims 1-28 are pending. Claims 2, 3, 7, 8, 10, 13, 14, 16, 17, 21, 22, 24, 27 and 28 have been canceled based on the preceding Restriction Requirement and Applicants' provisional election of Group I. As a result, Claims 1, 4, 5, 6, 9, 11, 12, 15, 18, 19, 20, 23, 25 and 26 have now been examined. All pending claims have been rejected. Applicants' herein respectfully request reconsideration based on the amended claims and the following.

Turning to the prior art rejections, Claims 1 and 15 have been rejected as being anticipated under 35 USC §102(e) by Fenster et al. (U.S. Patent No. 6,461,298). Applicants' disagree with this rejection and traverse as follows:

First and in order to anticipate under the Statute, each and every claimed limitation must be found, either implicitly as explicitly, in the single cited reference. Those limitations that are not found in the cited art must be notoriously well known to one of ordinary skill in the field.

Fenster et al. describes an ultrasound imaging system for creating and storing three-dimensional images of a target wherein digitized two-dimensional images can be used to generate a displayed three-dimensional image. More specifically, system calibration data as well as position data can be saved within a file that is entirely separate from that of the digitized image data. Critical to the discussion, however, and distinct from the present application teachings are that the different storages of Fenster are not made within computer image files such as JPEG or bit maps, but rather within different memory devices. To that end, Applicants' have clarified Claims 1 and 15 to now more distinctly and clearly recite that the method comprises the steps of embedding data specific to a measurement system of at least one of an endoscope and a borescope into a computer image file and more particularly into a selected file format, such as JPEG, bitmap, TIFF, etc., and selectively retrieving the specific data by a custom application directly from the computer image file, thereby allowing re-measurement using the at least one of endoscope and borescope without requiring a separate image file. Support for these amendments is found repletely in the specification, see also Fig. 1. Therefore, no new matter has been added.

Fenster et al. fails to describe these features, even remotely. Therefore, there can be no anticipation under the Statute. Reconsideration is respectfully requested.

Claims 4 and 18 have been rejected under 35 USC §102(e) as being anticipated by Parulski et al. (U.S. Patent No. 6,310,647). Applicants' respectfully traverse this rejection based on the following.

As noted above and in order to anticipate, each and every claimed limitation must be found in the single cited reference. Parulski '647 describes a storage technique for data using a photographic system but not using at least one of a borescope and an endoscope. Claims 4 and 18 have each been amended to more clearly define this essential feature of the present invention. Support for these amendments are also found in the pending specification, see also Fig. 1. Therefore, no new matter has been added. Reconsideration is respectfully requested.

Claims 5, 9, 11, 19, 23 and 25 have been rejected under 35 USC §103(a) as being unpatentable over Parulski '647.

As in preceding and in order to maintain a *prima facie* obviousness rejection under the Statute, every essential limitation of the claim must be suggested or taught by the cited prior art, either singly or in combination. The combination must be apparent from the prior art as a whole looking at the problem to be solved at the time of the invention, and not as a matter of impermissible hindsight. Those features/limitations that are not found or suggested by the prior art must be notoriously well known in the field by one of sufficient skill.

The Examiner has noted herein that Parulski '647 fails to disclose means for obtaining image-specific data but that this patent does teach storage of a first data value related to the image. The discussions that are provided, however, relate only to camera (photographic) specific data and not to data relating to an endoscopic or borescopic measurement system, including the storage of image data and image-specific data. The subject matter of Claims 6 and 20 have now been added to Claims 5 and 19. Claims 6 and 20 have been canceled. No new matter has been added. Claims 11, 19, 23 and 25 are believed allowable for the same reasons, since these claims are dependent upon Claims 5 and 19. Reconsideration is respectfully requested.

Claims 6, 12, 20 and 26 have been rejected under 35 USC §103(a) as being unpatentable over Parulski '647 in view of Fenster et al. Applicants' respectfully traverse this rejection.

As noted above and in order to maintain a *prima facie* obviousness rejection under the Statute, every essential limitation of the claim must be suggested or taught by the cited prior art, either singly or in combination. The combination must be apparent from the prior art as a whole looking at the problem to be solved at the time of the invention, and not as a matter of impermissible hindsight. Those features/limitations that are not found or suggested by the prior art must be notoriously well known in the field by one of sufficient skill.

Applicants' disagree. The probe system of Fenster et al. is not in any way related to that of an endoscopic/borescopic system used for remote visual inspections of industrial or medical targets. Rather, this system is used for an ultrasound imaging system having probe 24 that is swept over a target volume along a discrete linear scanning path. The system is not in any way directed to an endoscope or borescope for performing remote inspections of industrial and/or medical targets by way of an extremely flexible probe that is insertable into a tortuous cavity wherein data relating to a specific measurement tip used with a probe of the borescope/endoscope is stored in the manner of the invention. The Parulski patent has already been briefly discussed and relates only to photographic applications using electronic still cameras. Neither reference in any way relates to a borescopic/endoscopic application.

Additionally, Fenster et al. is not combinable with Parulski '647 in that Fenster et al. does not store both image data and image-specific (calibration, overlay, other system related) data in a single image file according to amended Claim 5. In fact, Fenster appears to provide no such need for this storage by in fact storing image data and specific data image in multiple image files and in fact teaches against this combined type of storage and therefore storage involving multiple selected file formats. Such teachings would obviate an obviousness rejection as posited by the Examiner. As noted, Claim 6 has now been canceled. Reconsideration is respectfully requested.

Claims 5, 6, 9, 11, 12, 19, 20, 23, 25 and 26 have been rejected under 35 USC §112, second paragraph, for indefiniteness. Applicants' have amended Claims 5 and 19 to clarify the limitations noted by the Examiner. To that end "medium" has now been deleted in favor of "image file" in order to more clearly define and particularly point out the invention. No new matter has been added. Withdrawal of this rejection is respectfully requested.

In summary, it is believed the above-captioned patent application is now in an allowable condition and such allowance is earnestly solicited.

Serial No.: 10/080,144
Amendment Dated: December 4, 2003
Reply to Office Action of June 6, 2003

If the Examiner wishes to expedite disposition of the above-captioned patent application, he is invited to contact Applicants' representative at the telephone number below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

By:

A handwritten signature in dark ink, appearing to read "Peter J. Bilinski", is written over a horizontal line.

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